REMARKS

Claims 1-5, 8-28, and 31-46 are pending in the present application. Claims 6, 7, 29, and 30 were canceled. Claims 1, 5, 8, 11, 12, 16, 18, 20-24, 28, 31, 34, 35, 39, 41, and 43-46 were amended. Reconsideration of the claims is respectfully requested.

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification.

I.   Telephone Interview with Examiner Smith on 01-12-05

Applicants thank Examiner Smith for the courtesy extended to Applicant's representative during the January 12, 2005 telephone interview. During the telephone interview, the Examiner and Applicant's representative discussed amending the independent claims to further distinguish the present invention from the cited references. Examiner Smith appeared to indicate that the amended independent claim language contained in this Response to Office Action would overcome the cited prior art references. Therefore, it is Applicants' representative's understanding that barring additional materially relevant prior art being found in an updated search by Examiner Smith, the present claims are now in condition for allowance. The substance of the interview is summarized in the remarks of Sections II-V, which follows below.

II.   35 U.S.C. § 102, Anticipation

The examiner has rejected claims 1-6, 9-12, 15, 20-21, 24-29, 32-35, 38, and 43-44 under 35 U.S.C. § 102 as being anticipated by *Surf Smart!* (published Oct. 18, 2000) <http://web.archive.org/web/20001018074520/http://cexx.org/gofaster.htm> (Hereinafter *Surf Smart*). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). All limitations of the claimed invention must be considered when determining patentability. (*In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994)). Anticipation focuses on whether a claim reads on the product or process

a prior art reference discloses, not on what the reference broadly teaches. (*Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983)).

A. Amended independent claim 1 of the present invention, which is representative of amended independent claims 20, 24 and 43, reads as follows:

> 1. A method in a data processing system for disabling collection of history information on a browser, the method comprising:
> receiving a user input, wherein the user input is the entry of a selected user identification; and
> responsive to receiving the user input, disabling history recording processes associated with the browser for an identified session, wherein the identified session is identified based on the selected user identification.

With regard to claim 1, the Examiner stated:

> Regarding independent claims 1, 24, and 43, Surf Smart discloses receiving user input and responsive to receiving the user input, disabling the history recording processes associated with the browser page 3.

(*Office Action*, dated October 20, 2004, Page 2).

Even though *Surf Smart* teaches receiving user input for disabling cookies and clearing history files for Web browsers (*Surf Smart*, Pages 2 and 3), *Surf Smart* does not identically teach every element of Applicants' present invention as recited in amended independent claim 1. Amended claim 1 of the current invention recites that the user input is the entry of a user identification. User identification is required to disable the history recording processes associated with the browser as recited in claim 1 of the present invention. In other words, disabling history recording processes cannot be achieved without the user identification in Applicants' current invention.

Surf Smart makes no reference to the use of user identification in the process of protecting online privacy. In *Surf Smart*, user input is by anyone with access to a computer's Web browser to enable or disable the history recording processes at will. *Surf Smart* does not require the identification of the user in order to disable the history recording processes as recited in claim 1 of the present invention. Therefore, *Surf Smart* does not teach this recited claim 1 limitation.

In addition, Examiner Smith stated on page 5 of the Office Action that, "...Surf Smart does not teach wherein the user input is the entry of a selected user identification."

(*Office Action*, Page 5). Applicants agree with Examiner Smith that *Surf Smart* does not teach this feature as recited in amended claim 1 of the current invention.

Moreover, *Surf Smart* does not teach that an identified session is identified based on a selected user identification as recited in amended claim 1 of Applicants' current invention. *Surf Smart* teaches the ability to disable history recording processes for a session. However, a session in *Surf Smart* is the termination of a browser session. In other words, *Surf Smart* will delete the entire history file and cookie storage when the browser is closed finishing the session. *Surf Smart* does not teach that an identified Web surfing history session to be deleted is based on a user identification as recited in amended claim 1 of the present invention.

By way of example, the Applicants' Specification teaches on page 17 that all cookies, cached files, history lists, and location lists may be deleted from a history for a particular user, while similar information for another user is retained. (*Application*, Page 17, line 29 – Page 18, line 1). Below, Figure 6 of the present invention illustrates that sessions 632 and 634 are identified based on a user identification, date, and time.
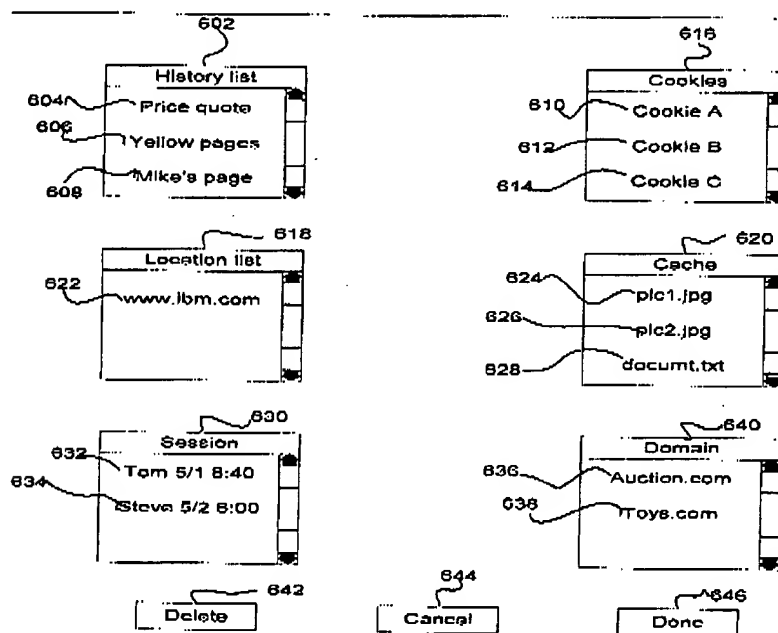
As is clearly represented in Figure 6 of Applicants' current invention above, an identified session may be determined by user identification (e.g., Tom, Session 632 and

Steve, Session 634). In the example depicted above, an identified user may disable his or her identified session's recorded history without disabling any other user identified sessions. In contrast, Surf *Smart* will disable all of the history list and all of the cookie storage at the termination of the browser session regardless of the number of users. Therefore, *Surf Smart* does not teach this recited feature of amended independent claim 1 of the current invention either.

As a result of the foregoing arguments, *Surf Smart* does not identically teach each and every element recited in Applicants' present invention. Accordingly, Applicants respectfully urge that the rejection of amended independent claims 1, 20, 24, and 43 under 35 U.S.C. § 102 be withdrawn.

B. Amended independent claim 11 of the present invention, which is representative of amended independent claims 21, 34 and 44, reads as follows:

> 11.   A method in a data processing system for disabling collection of history information in a browser, the method comprising:
> responsive to receiving a particular Web page, displaying an option to prevent recording a history; and
> responsive to a user input selecting the option, wherein the user input is the entry of a selected user identification, disabling processes used to record the history.

With regard to claim 11, the Examiner stated:

> Regarding independent claims 11, 34, and 44, Surf Smart discloses responsive to receiving a particular Web page, displaying an option to prevent recording a history and responsive to a user input selecting the option, disabling processes used to record the history in page 2.

(*Office Action*, Page 3).

Even though *Surf Smart* teaches receiving user input for disabling cookies for a particular Web page (*Surf Smart*, Page 2), *Surf Smart* does not identically teach every element of Applicants' present invention as recited in amended independent claim 11. Amended claim 11 of the current invention recites that the user input is the entry of a user identification. User identification is required to disable the history recording processes associated with the browser as recited in claim 11 of the present invention. In other words,

disabling history recording processes cannot be achieved without the user identification in Applicants' current invention.

Surf Smart makes no reference to the use of user identification in the process of protecting online privacy. In *Surf Smart*, user input is by anyone with access to a computer's Web browser to enable or disable the history recording processes at will. *Surf Smart* does not require the identification of the user in order to disable the history recording processes as is recited in claim 11 of the present invention. Therefore, *Surf Smart* does not teach this recited claim 11 limitation.

Additionally, Examiner Smith stated on page 5 of the *Office Action* that, "...Surf Smart does not teach wherein the user input is the entry of a selected user identification." (*Office Action*, Page 5). Applicants agree with Examiner Smith that *Surf Smart* does not teach this feature as recited in amended claim 11 of the current invention.

As a result of the foregoing arguments, *Surf Smart* does not identically teach each and every element recited in Applicants' present invention. Accordingly, Applicants respectfully urge that the rejection of amended independent claims 11, 21, 34, and 44 under 35 U.S.C. § 102 be withdrawn.

C. In view of the arguments contained in Sections I-A and I-B above, Applicants respectfully submit that each element of amended independent claims 1, 11, 20, 21, 24, 34, 43, and 44 are not identically taught by *Surf Smart*. Claims 2-10, 12-15, 25-33, and 35-38 are dependent claims depending on the aforementioned independent claims. Applicants have already demonstrated claims 1, 11, 20, 21, 24, 34, 43, and 44 to be in condition for allowance. Therefore, Applicants respectfully submit that claims 2-10, 12-15, 25-33, and 35-38 are also allowable, at least by virtue of their dependence on allowable claims.

Furthermore, dependent claims 5, 8, 12, 28, 31, and 35 contain features not taught by the *Surf Smart* reference.

D. Amended dependent method claim 5, which is representative of amended dependent method claim 12 and apparatus claims 28 and 35, reads as follows:

> 5.   The method of claim 1, wherein the history recording processes includes at least one of a disk cache process, a history list process, a location list process, and a cookie storage process.

With regard to claim 5, the Examiner stated:

> Regarding dependent claims 5 and 28, Surf Smart discloses wherein the history recording processes includes at least one of a disk cache process, a history list process, and a cookie storage process in pages 2 and 3.

(*Office Action*, Page 3).

Surf Smart teaches that the history recording processes to be disabled are cookies and history files for Web browsers (*Surf Smart*, Pages 2 and 3). However, Applicants' present invention recites in amended claim 5 that the history recording processes that may be disabled are a disk cache process, a history process, a location list process, and a cookie storage process. In other words, Applicants' current invention has the ability to disable a disk cache and a location list from recording a user's Web surfing history in addition to the history list and cookie storage, whereas *Surf Smart* only teaches the ability to disable the cookie storage and history file. Therefore, *Surf Smart* does not identically teach each recited limitation of claims 5 and 28 of the present invention.

E. Amended dependent method claim 8, which is representative of amended dependent apparatus claim 31, reads as follows:

> 8. The method of claim 1, wherein the selected user identification is a temporary user identification.

With regard to claim 8, the Examiner stated:

> Regarding dependent claims 8 and 31, Surf Smart does not teach wherein the selected user identified is a temporary user identification.

(*Office Action*, Page 6).

Applicants agree with Examiner Smith that *Surf Smart* does not teach that the selected user identified is a temporary user identification as recited in claim 8 of the Applicants' current invention. (*Office Action*, Page 6). Therefore, *Surf Smart* does not teach the recited feature of claims 8 and 31 of the present invention.

Accordingly, Applicants submit once again that *Surf Smart* does not identically teach each and every element recited in the claims of the current invention. Thus,

Applicants respectfully urge that the rejection of claims under 35 U.S.C. § 102 as being anticipated by *Surf Smart* be withdrawn.

III. 35 U.S.C. § 103, Obviousness, Dependent Claims 13, 14, 36, and 37

The Examiner has rejected claims 13, 14, 36, and 37 under 35 U.S.C. § 103 as being unpatentable over *Surf Smart*. This rejection is respectfully traversed.

Method claims 13 and 14 and apparatus claims 36 and 37 are dependent on amended independent claims 11 and 34, respectively. In Section I-B above, Applicants have already demonstrated claims 11 and 34 to be in condition for allowance. Therefore, Applicants respectfully submit that claims 13, 14, 36, and 37 are also allowable, at least by virtue of their dependence on allowable claims. Accordingly, Applicants respectfully urge that the rejection of dependent claims 13, 14, 36, and 37 under 35 U.S.C. § 103 as being unpatentable over *Surf Smart* be withdrawn.

IV. 35 U.S.C. § 103, Obviousness, Dependent Claims 7, 8, 30, and 31

The Examiner has rejected claims 7, 8, 30, and 31 under 35 U.S.C. § 103 as being unpatentable over *Surf Smart* as applied to claims 1 and 24 above, and further in view of *HistoryKill* (published Mar. 4, 2000) <http://web.archive.org/web/20000304120647/http://www.historykill.com> (Hereinafter *HistoryKill*). This rejection is respectfully traversed.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. (*In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992)). For an invention to be prima facie obvious, the prior art must teach or suggest all claim limitations. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

A. Canceled dependent method claim 7 had its claim language incorporated into independent claim 1 of the present invention. Claims 1 and 7 are representative of claims 24 and 30, respectively. In addition, independent claim 1 is representative of independent claim 20 and 43. Amended independent claim 1 of Applicants' current invention reads as follows:

1. A method in a data processing system for disabling collection of history information on a browser, the method comprising:

    receiving a user input, wherein the user input is the entry of a selected user identification; and

    responsive to receiving the user input, disabling history recording processes associated with the browser for an identified session, wherein the identified session is identified based on the selected user identification.

With regard to claim 7, the Examiner stated:

Regarding dependent claims 7 and 30, Surf Smart does not teach wherein the user input is the entry of a selected user identification. HistoryKill does teach wherein user input disabling recording processes associated with a browser is the entry of selected user identification in page 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Surf Smart with the teaching of HistoryKill to have created the claimed invention. It would have been obvious and desirable to have used the user identification of HistoryKill to have personalized the disabling of history recording processes for each user of Surf Smart.

(*Office Action*, Pages 5 and 6).

Even though *HistoryKill* teaches that the user input for disabling recording processes associated with a browser is the entry of selected user identification, *HistoryKill* does not teach or suggest all claim limitations of Applicants' present invention as recited in amended independent claim 1. Claim 1 of the current invention recites that the history recording processes associated with the browser for an identified session may be disabled by the associated user identification. *HistoryKill* makes no reference to identification of sessions based on the selected user identification.

HistoryKill is merely limited to one selected user identification at a time, whereas the present invention as recited in amended independent claim 1 will permit multiple user identifications. Please refer to the Section I-A argument above, starting on page 16, with reference to *Surf Smart* not teaching that an identified browser session is identified based on the selected user identification as is recited in the current invention's claim 1. The immediately referenced Section I-A argument is also applicable to *HistoryKill*.

Furthermore, Examiner Smith stated on page 6 of the *Office Action* that, "*HistoryKill* does not teach receiving user input selecting a session from the identification

of sessions and discarding history information for the session." (*Office Action,* Page 6). Applicants agree with Examiner Smith that *HistoryKill* does not teach this feature as recited in amended claim 1 of the current invention. Therefore, *HistoryKill* does not teach or suggest this recited feature of amended independent claim 1 of the current invention.

Accordingly, Applicants respectfully urge that the rejection of amended independent claims 1, 20, 24, and 43 under 35 U.S.C. § 103 as being unpatentable over *Surf Smart* and further in view of *HistoryKill* be withdrawn.

B. In view of the immediately preceding arguments, Applicants respectfully submit that all claim limitations of amended independent claims 1, 20, 24, and 43 are not taught or suggested by the combination of the cited references. Claims 8 and 31 are dependent claims depending on the aforementioned independent claims. Applicants have already demonstrated claims 1, 20, 24, and 43 to be in condition for allowance. Therefore, Applicants respectfully submit that claims 8 and 31 are also allowable, at least by virtue of their dependence on allowable claims.

V.   35 U.S.C. § 103, Obviousness, Claims 16-19, 22-23, 39-42, and 45-46

The Examiner has rejected claims 16-19, 22-23, 39-42, and 45-46 under 35 U.S.C. § 103 as being unpatentable over *HistoryKill*. This rejection is respectfully traversed.

A. Amended independent claim 16 of the present invention, which is representative of amended independent claims 22, 39, and 45, reads as follows:

> 16.   A method in a data processing system for selectively preventing collection of history information on a browser, the method comprising:
>   responsive to a selected event, displaying an identification of sessions, wherein the identification of a session is based on a selected user identification; and
>   responsive to receiving a user input selecting a session from the identification of sessions, wherein the user input is the entry of the selected user identification, discarding history information for the session.

With regard to claim 16, the Examiner stated:

> Regarding independent claims 16, 39, and 45, HistoryKill teaches responsive to a selected event, discarding history information for a session on pages 1-2. HistoryKill teaches accepting user input to indicate whether

history information should be discarded for the session or not in pages 1-2. HistoryKill does not teach receiving user input selecting a session from the identification of sessions and discarding history information for the session.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified HistoryKill to have accepted user input to identify a session in response to a selected event so that the user could have sometimes discarded history information and other times retained history information. HistoryKill teaches in page 1 that user input can discard selected history information and retain other information, thus teaching that a user may not always wish to discard history information. Therefore, the preference of user to not always remove history information, or not remove all history information would have motivated this modification.

(*Office Action*, Pages 6 and 7).

HistoryKill teaches that an identified user may selectively disable whichever listed history recording processes he or she desires for that browser session. However, *HistoryKill* does not teach or suggest that history recording processes are associated with **identified sessions** as is recited in amended independent claim 16 of the present invention. *HistoryKill* makes no reference to selecting a session from a list of identified sessions based on selected user identification as is recited in amended independent claim 16 of the present invention. The selection of history recording processes for a particular browser session as taught in *HistoryKill* is distinguishable from the selection of an identified session from a list of identified sessions as is recited in amended independent claim 16 of Applicants' current invention. Therefore, *HistoryKill* does not teach or suggest all claim limitations as recited in claim 16 of the present invention.

Also, arguments contained in Sections I-A and IV-A above are applicable to amended independent claim 16 and therefore are herein applied. In addition, Examiner Smith stated that, "*HistoryKill* does not teach receiving user input selecting a session from the identification of sessions and discarding history information for the session." (*Office Action*, Page 6). Applicants agree with Examiner Smith that *HistoryKill* does not teach this limitation recited in amended claim 16 of the current invention.

Since *HistoryKill* does not teach or suggest Applicants' recited limitation of selecting a session from the identification of sessions in claim 16, then it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have

modified *HistoryKill* to reach the current invention. In determining obviousness, an applicant's teachings may not be read into the prior art. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1575 n. 29, 1 U.S.P.Q. 1593, 1602 n. 29 (Fed. Cir. 1987) (citing need to "guard against hindsight and the temptation to read the inventor's teachings into the prior art").

Accordingly, Applicants respectfully urge that the rejection of amended independent claims 16, 22, 39, and 45 under 35 U.S.C. § 103 as being unpatentable over *HistoryKill* be withdrawn.

B. Amended independent claim 18 of the present invention, which is representative of amended independent claims 23, 41, and 46, reads as follows:

> 18. A method in a data processing system for selectively preventing collection of history information on a browser, the method comprising:
> responsive to a selected event, displaying an identification of domains in which a history information has been collected; and
> responsive to receiving a user input selecting a domain from the identification of domains, wherein the user input is the entry of the selected user identification, discarding history information for the domain.

With regard to claim 18, the Examiner stated:

> Regarding independent claims 18, 41, and 46, HistoryKill teaches responsive to a selected event, discarding history information for a session on page 1-2. HistoryKill teaches accepting user input to display an identification of domains in which history information is collected in pages 1-2. A cookie manager displays a list of domains and their related cookie history information. A user can selectively remove the history information for each domain.
> It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified HistoryKill to have created the claimed invention. It would have been obvious and desirable to have used the selective domain identification contained in the Web browser configuration to have improved the discarding of history information in response to a selective event as taught by HistoryKill so that user could have only removed history information for selected Web sites as is the purpose of selective cookie deleting in the cookie manager of a Web browser. HistoryKill teaches in page 2 that the Auto-Clearing and Auto-Configure features enable a user to avoid manually clearing history

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information after each session. The combination of teachings would have allowed certain domains of history information to be retained automatically while removing only specific history information.

(*Office Action*, Pages 7 and 8).

HistoryKill teaches that an identified user may selectively disable the history recording processes listed on the *HistoryKill* screen for that browser session. The *HistoryKill* Screen Capture shows that the listed disabling options are: URL drop list, History file, Cache, Cookies, and All. After the identified user in *HistoryKill* makes the desired selections from the list of history recording processes, he or she will then "hit" the Kill button to **disable the entire contents** of the selected history recording processes. *HistoryKill* does not teach or suggest an option for selecting a subset of items contained within the URL drop list, History file, Cache, or Cookies. Consequently, *HistoryKill* teaches that the selection of history recording processes is either all or none.

In contrast, amended independent claim 18 of the present invention recites that an identified user may select a domain from a list of identified domains for a browser session. In other words, Applicants' current invention will allow the identified user to selectively disable domains from a list of identified domains for a browser session based on the user identification. *HistoryKill* makes no reference to selecting a domain from a list of identified domains based on selected user identification as is recited in claim 18 of the current invention. Therefore, *HistoryKill* does not teach or suggest all claim limitations as recited in amended independent claim 18 of the present invention.

Since *HistoryKill* does not teach or suggest Applicants' recited limitation of selecting a domain from the identification of domains in claim 18, then it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have modified *HistoryKill* to reach the current invention. Accordingly, Applicants respectfully urge that the rejection of amended independent claims 18, 23, 41, and 46 under 35 U.S.C. § 103 as being unpatentable over *HistoryKill* be withdrawn.

C. In view of the arguments contained in Sections V-A and V-B above, Applicants submit that all limitations of amended independent claims 16, 18, 22, 23, 39, 41, 45, and 46 are not taught or suggested by *HistoryKill*. Claims 17, 19, 40, and 42 are dependent claims depending on the aforementioned independent claims. Applicants have

already demonstrated claims 16, 18, 22, 23, 39, 41, 45, and 46 to be in condition for allowance. Therefore, Applicants respectfully submit that claims 17, 19, 40, and 42 are also allowable, at least by virtue of their dependence on allowable claims.
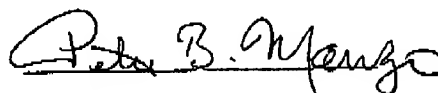
VI.   **Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 01-21-05

Respectfully submitted,

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